

The stated basis for the new matter rejection and the rejection of these claims for lack of written description is:

There is no mention in the original specification of a SCC polymer ' being present in amount such that it thickens the oil'.

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According to the applicable law,

[w]hen determining when the disclosure is sufficient,

the test . . . is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter[.]"

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Turbocare v. General Electric Co., 264 F.3d 1111,1118, 60 U.S.P.Q. 2d 1017 (Fed. Cir. 2001) (quoting Vas-Cath, Inc. v Mahurkar, 935 F. 2d 1555, 1563, 19 U.S.P.Q 2d 1111, 1116 (Fed. Cir. 1991)).

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In his declaration, David C. Steinberg, expert in the chemistry of cosmetic products, unequivocally states in paragraph 9:

It is my opinion that the language "The polymeric thickener should be used in an amount sufficient to thicken the oil" is inherently within the original disclosure and one skilled in the art would recognize that this was disclosed. Further, It is my opinion that the original disclosure reasonably conveyed to one skilled in the art that the inventor had possession of the claimed subject matter at the time of filing, in particular the subject matter of claims 1-5, 9-12, 20-25 and 37-40.

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Dr. Steinberg provides ample factual basis for his opinion.

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There is no evidence contrary to Mr. Steinberg's opinion. As such, withdrawal of this rejection is respectfully requested.

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2. The Rejection of Claims 1-5, 9-12, 20, 37 and 38 for Lack of Enablement.

Claims 1-5, 9-12, 20, 37 and 38 have been rejected for lack of enablement. The stated basis for this ground of rejection is:

5 *There is nothing in the original specification to guide one of ordinary skill in the art, to determine the level of concentration at which the polymer starts to thicken the oil.*

10 In the previous reply, Applicant pointed out examples in the specification, which guide one of ordinary skill in the art to determine the level of concentration at which the polymer starts to thicken in the oil. It is well settled law that,

[t]here is no magical relation between the number of representative examples and the breadth of the claims; the number and variety of examples are irrelevant if the disclosure is "enabling" and set forth in the "best mode contemplated."

15 In Re Borkowski, 164 U.S.P.Q. 642, 646 (CCPA 1970); see also In re Angstadt, 537 F.2d 498 (C.C.P.A. 1978).

Further, Mr. Steinberg states in his declaration, at paragraph 11:

20 *[i]t is my opinion that the claimed subject matter is described in the original specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention without undue experimentation, in particular, the subject matter of claims 1-5, 9-12, 20-25 and 37-40.*

Mr. Steinberg goes on to say in paragraph 11 part iii:

25 *using the compounds (polymers) and oils disclosed in the specification, it would only take one skilled in the art and having the necessary equipment a short amount of time to determine the amount of polymer needed to achieve the desired thickness.*

30 Applicant asserts, therefore, that the specification contains enablement commensurate in scope with the protection sought by the claims.

It is well-settled law that under the present circumstances, a rejection of lack of enablement must be withdrawn unless the Examiner substantiates the rejection by reason or evidence. For example, the CCPA, in In re Budnick, 190 USPQ 422, observed,

Where an applicant has asserted that the specification contains enablement commensurate in scope with the protection sought by the claims, but the Examiner is of the opinion that the disclosure is not enabling, he has the burden of substantiating his doubts concerning enablement with reason or evidence.

In the present case, the Examiner has not substantiated his doubts in anyway. He has merely **asserted** that the specification is not enabling. It is submitted, therefore, that the rejection should be withdrawn.

3. The Rejection of Claims 21-25, 39 and 40 for Lack of Written Description

Each of claims 21-25, 39 and 40 requires, directly or indirectly, that the composition contains at least 2% by weight of the SCC polymer.

The stated basis for the rejection of these claims for lack of written description is: *The "at least 2% by weight" concentration level of the SCC polymer cannot be found in the specification.*

As previously stated, when determining when the disclosure is sufficient the test . . . is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter

Turbocare v. General Electric Co., 264 F.3d 1111,1118, 60 U.S.P.Q. 2d 1017 (Fed. Cir. 2001) (quoting Vas-Cath, Inc. v Mahurkar, 935 F. 2d 1555, 1563, 19 U.S.P.Q 2d 1111, 1116 (Fed. Cir. 1991)).

In his declaration, with a factual basis specified, Mr. Steinberg, states in paragraph 9:

It is my opinion that the language "The polymeric thickener should be used in an amount sufficient to thicken the oil" is inherently within the original disclosure and one skilled in the art would recognize that this was disclosed. Further, It is my opinion that the original disclosure reasonably conveyed to one skilled in the art that the inventor had possession of the claimed subject matter at the time of filing, in particular the subject matter of claims 1-5, 9-12, 20-25 and 37-40.

There is no evidence contrary to Mr. Steinberg's opinion. As such, withdrawal of this rejection is respectfully requested.

4. The Rejection of Claims 21-25, 39 and 40 for Lack of Enablement

Each of claims 21-25, 39 and 40 requires, directly or indirectly, that the composition contains at least 2% by weight of the SCC polymer.

The stated basis for the rejection of these claims for lack of enablement is:

The specification, while being enabling for the 2 -10% by weight concentration range of the SCC polymer, does not reasonably provide enablement for a 2-100% by weight concentration range of the SCC polymer.

In the previous reply, Applicant pointed out examples in the specification that support claims in which the composition contains at least 2% by weight of the SCC polymer.

It is well settled law that,

[t]here is no magical relation between the number of representative examples and the breadth of the claims; the number and variety of examples are irrelevant if the disclosure is "enabling" and set forth in the "best mode contemplated[.]"

In Re Borkowski, 164 U.S.P.Q. 642, 646 (CCPA 1970).

In his declaration, at paragraph 11, Mr. Steinberg states:

[i]t is my opinion that the claimed subject matter is described in the original specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention without undue experimentation, in particular, the subject matter of claims 1-5, 9-12, 20-25 and 37-40.

Mr. Steinberg goes on to say at paragraph 11, part iii:

[u]sing the compounds (polymers) and oils disclosed in the specification, it would only take one skilled in the art and having the necessary equipment a short amount of time to determine the amount of polymer needed to achieve the desired thickness.

Applicant asserts, therefore, that the specification contains enablement commensurate in scope with the protection sought by the claims.

Moreover, the present situation is similar to that In re Johnson and Farnham, 558 F.2d 10008, 1017, 194 U.S.P.Q. 187, 195 (CCPA 1977), where the examiner rejected claims for lack of enablement. The examiner tried to restrict the claims based on ranges given in the description of the best mode. In its decision, the CCPA stated:

[t]he PTO would limit appellants to claims reciting a sigma value of at least 0.7. This view is improper because it requires the claims to set forth the practical limits of operation for the invention and it effectively ignores the scope of enablement provided by the specification as a whole. As we said in In re Goffe, 542, F.2d 564, 567, 191 U.S.P.Q. 429, 431 (CCPA 1976):*

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve

the constitutional purpose of promoting progress in the useful arts. See In re Fuetterer, 50 CCPA 1453, 1462, 319 F.2d 259, 265, 138 U.S.P.Q. 217, 223 (1963) [footnote omitted]

See also In re Geiger, 815 F.2d. 686, 690, 2 U.S.P.Q. 2d 1276, 1276 (Fed. Cir. 1987).

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Likewise, Applicant's should not be required to restrict their claims to a preferred embodiment given in the specification.

10 It is well-settled law that under such circumstances, a rejection of lack of enablement must be withdrawn unless the Examiner substantiates the rejection by reason or evidence. For example, the CCPA, in In re Budnick, 190 USPQ 422, observed

15 *Where an applicant has asserted that the specification contains enablement commensurate in scope of the protection sought by the claims, but the Examiner is of the opinion that the disclosure is not enabling, he has the burden of substantiating his doubts concerning enablement with reason or evidence.*

In the present case, the Examiner has not substantiated his doubts in anyway. He has merely **asserted** that the specification is not enabling. It is submitted, therefore,
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